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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,664	01/19/2004	Duane Bloom	WESTERN.023C1	8055

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EXAMINER

NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,664

Applicant(s)

BLOOM ET AL

Examiner

William P. Neuder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/29/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-134 of U.S. Patent No. 6,679,341. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the claims of 6,679,341. The claims of 6,679,341 fully encompass the instant claims.

Claims 1-10, 13 and 16-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-78 of U.S. Patent No. 6,347,674. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 6,347,674 fully encompass the instant claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10,13,16-21,23,24,26,28,31 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloom et al 6,347,674

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bloom discloses a tractor assembly for moving within a borehole. First and second gripper assemblies 104,106 are slidable coupled to the body for selectively gripping an inner surface of the borehole. First 108,110 and second 112,114 propulsion assemblies propel the tool through the borehole. The first propulsion means propelling the tool when the first gripper is engaged and the second propulsion means propelling the tool when the second gripper is engaged. A gripper control valve 154 has a first position configured to direct fluid to the first gripper and a second position configured to

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direct fluid to the second gripper. A propulsion valve 156 has a first position configured to direct fluid to the first propulsion means and a second configuration for directing fluid to the second propulsion means. The tractor assembly is configured for use with coiled tubing. As to claim 2, the valve system receives fluid from the surface for providing hydraulic power to the assembly. As to claim 3, the speed of the tractor movement is directly proportional to the pressure and flow rate of the pressurized fluid in the valve assembly. As to claim 4, the position of the gripper control valve is controlled by fluid pressure in the propulsion assemblies. As to claim 5, the fluid in the propulsion means effect movement of the grippers following propulsion of the tool. As to claim 6, the position of the propulsion control valve is controlled by fluid pressures in the first and second flow paths. As to claim 8, the propulsion control valve has a spool 304, the first and second flow paths being in communication with opposite ends of the spool. As to claim 9, expansion of the grippers produce fluid pressure changes in the flow paths, wherein the propulsion control valve changes position after a difference in the fluid pressures exceeds a predetermined threshold. As to claim 10, the difference in the pressure exceeds the threshold only after the grippers are fully extended. As to claim 13, first and second 144,146 pistons are provided in propulsion chambers 112,110. As to claim 16, the grippers expand radially. As to claim 17, the tool has an internal passage. As to claim 18, the valve system is housed within the tool. As to claim 19, the rate of advancement of the tool is controlled by the pressure and flow rate of the fluid. As to claim 20, the speed of the tool is controlled by the tension exerted on the tool by the drill string. As to claim 21, the tool is connectable to another well component. As to

claims 23,24,26 and 28, the well component can be An acidizing tool, a sandwashing tool, a logging tool or a MWD tool. As to claim 30, an E-line is provided. As to claim 34, the propulsion control valve is piloted by fluid pressures in the grippers.

Claims 1-10,13,16-21,23,24,26,28,30 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Beaufort et al 6,241,031

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bloom discloses a tractor assembly for moving within a borehole. First and second gripper assemblies 42,52 are slidable coupled to the body for selectively gripping an inner surface of the borehole. First 24 and second 26 propulsion assemblies propel the tool through the borehole. The first propulsion means propelling the tool when the first gripper is engaged and the second propulsion means propelling the tool when the second gripper is engaged. A gripper control valve 62 has a first position configured to direct fluid to the first gripper and a second position configured to direct fluid to the second gripper. A propulsion valve 56 has a first position configured to direct fluid to the first propulsion means and a second configuration for directing fluid to the second propulsion means. The tractor assembly 20 is configured for use with coiled tubing. As to claim 2, the valve system receives fluid from the surface for

providing hydraulic power to the assembly. As to claim 3, the speed of the tractor movement is directly proportional to the pressure and flow rate of the pressurized fluid in the valve assembly. As to claim 4, the position of the gripper control valve is controlled by fluid pressure in the propulsion assemblies. As to claim 5, the fluid in the propulsion means effect movement of the grippers following propulsion of the tool. As to claim 6, the position of the propulsion control valve is controlled by fluid pressures in the first and second flow paths. As to claim 8, the propulsion control valve has a spool, the first and second flow paths being in communication with opposite ends of the spool. As to claim 9, expansion of the grippers produce fluid pressure changes in the flow paths, wherein the propulsion control valve changes position after a difference in the fluid pressures exceeds a predetermined threshold. As to claim 10, the difference in the pressure exceeds the threshold only after the grippers are fully extended. As to claim 13, first and second 34,36 pistons are provided in propulsion chambers 44,46. As to claim 16, the grippers expand radially. As to claim 17, the tool has an internal passage. As to claim 18, the valve system is housed within the tool. As to claim 19, the rate of advancement of the tool is controlled by the pressure and flow rate of the fluid. As to claim 20, the speed of the tool is controlled by the tension exerted on the tool by the drill string. As to claim 21, the tool is connectable to another well component. As to claims 23,24,26 and 28, the well component can be An acidizing tool, a sandwashing tool, a logging tool or a MWD tool. As to claim 30, an E-line is provided. As to claim 34, the propulsion control valve is piloted by fluid pressures in the grippers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22,25,27,29,32,33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloom et al.

As to claims 22,25,27 and 29, the type of downhole tool connected to the tractor would have been considered an obvious design choice. Since tools such as MWD, logging acidizing and sandwashing are connected to the tractor, and the purpose of a tractor is to convey tools through a borehole, it would have been considered obvious to connect any known well tool to the tractor assembly. As to claims 32 and 33, the exact amount of pull and pressure exerted would have been considered obvious since the amounts depend on the type of tools conveyed and the integrity of the borehole. As to claim 35, the system also uses electricity. It would have been considered well within the skill of one of ordinary skill in the art to design the system to be only hydraulic.


Claims 22,25,27,29,32,33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaufort et al.

As to claims 22,25,27 and 29, the type of downhole tool connected to the tractor would have been considered an obvious design choice. Since tools such as MWD, logging acidizing and sandwashing are connected to the tractor, and the purpose of a tractor is to convey tools through a borehole, it would have been considered obvious to connect any known well tool to the tractor assembly. As to claims 32 and 33, the exact amount of pull and pressure exerted would have been considered obvious since the amounts depend on the type of tools conveyed and the integrity of the borehole. As to claim 35, the system also uses electricity. It would have been considered well within the skill of one of ordinary skill in the art to design the system to be only hydraulic.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William P Neuder
Primary Examiner
Art Unit 3672

W.P.N.